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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/780,634

02/19/2004

Yoshiaki Kato

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08/24/2004

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EXAMINER

SOUW, BERNARD E

ART UNIT

PAPER NUMBER

2881

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,634

Applicant(s)

KATO, YOSHIAKI

Examiner

Bernard E Souw

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 18-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/19/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/JP01/09730, filed on 11/07/2001.

Preliminary Amendment

2. The Preliminary Amendment filed 12/17/2003 has been entered.
Claims 1-17 have been cancelled.
New claims 18-30 have been added.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 18 recites the phrase "*ion trap type mass spectrometer*", which renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Double Patenting

Statutory Type Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to

identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claim 18 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued. This is a double patenting rejection.

5. Claim 19 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 3 of prior U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued. This is a double patenting rejection.

6. Claim 20 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 5 of prior U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued. This is a double patenting rejection.

7. Claim 22 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 7 of prior U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued. This is a double patenting rejection.

8. Claim 23 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 8 of prior U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued. This is a double patenting rejection.

9. Claim 25 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 9 of prior U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued. This is a double patenting rejection.

10. Claim 26 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 22 of prior U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued. This is a double patenting rejection.

11. Claim 27 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 23 of prior U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued. This is a double patenting rejection.

12. Claim 28 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 24 of prior U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued. This is a double patenting rejection.

13. Claim 29 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 25 of prior U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued. This is a double patenting rejection.

14. Claim 30 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 26 of prior U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued. This is a double patenting rejection.

Non-Statutory Type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Obviousness Type Double Patenting

15. Claims 21 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Application No. 10/239,764 which has been allowed 06/30/2004 but not yet been issued, in view of Kelley (USPAT 5,451,782), hereinafter Kelley'782.

Claim 5 of the allowed US Application No. 10/239,764 shows all the limitations of claims 21 and 24, except the recitation that the frequency and voltage of the supplementary AC voltage in the third step of claim 5 (which is identical to claim 20 of the present application) are fixed and the main frequency voltage is swept from high voltage to low voltage (present claim 21), or from low voltage to high voltage (present claim 24). These limitations are rendered obvious by Kelley, as recited in Col.4/ll.52-55 and in the Abstract/ll.20-25, whereby the phrase "*at least one parameter of the trapping field*" covers the main frequency voltage. The recitation of a specific sweep from high voltage to low voltage (present claim 21), and from low frequency to high frequency

(present claim 24) are both inherent in Kelley'782, since such a sweep or scan **must** be conducted from one end to the other end of the scan range, and Kelley does not specify any specific scan or sweep direction, which also means it is not critical and therefore can be performed in either one of the two possible scan directions.


Communications

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard E Souw whose telephone number is 571 272 2482. The examiner can normally be reached on Monday thru Friday, 9:00 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R Lee can be reached on 571 272 2477. The central fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications as well as for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.

bes
August 20, 2004


JOHN R. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800